

REMARKS

Claims 1-48 are pending, with claims 1-5, 15-17, 21, 22, 42-46, and 48 rejected, and claims 2-4, 6-14, 18-20, 23-41, and 47 objected to. The rejections include a mix of indefiniteness rejections, anticipation rejections, and obviousness rejections. Applicant addresses all of the indefiniteness rejections in the above amendments, and all of the informality objections noted by the examiner, as well, and explains in the below arguments why the anticipation and obviousness rejections fail as a matter of law.

First, while understandable, many of the examiner's claim informality objections offered in consideration of 37 C.F.R. § 1.75 should be withdrawn. For example, the examiner states that claim 10 should be amended such that line 2 should use "the maximum usage threshold" rather than "a maximum usage threshold," to reflect antecedent basis for the term in claim 1, from which claim 10 depends. However, Applicant notes that claim 10 reads, in relevant part, "[t]he method of claim 1 wherein increasing a data rate capacity of the radio channel if the usage remains above a maximum usage threshold for a first qualified period of time comprises...."

From this excerpt, the examiner can see that claim 10 includes a full restatement of the claim 1 limitation it relates to, and thus it is appropriate to restate the claim 1 limitation using the exact language of claim 1. Almost all of the other examples identified by the examiner as a failure by Applicant to reflect antecedent basis are, in reality, examples of the Applicant restating the full limitation of a parent claim as the preamble of a dependent claim. However, please note that Applicant did catch several claim informalities, and addressed those mistakes in the above claim amendments—see claims 2, 27, 34, and 38.

Turning to the 112-based rejections, the above amendments address all antecedent issues noted by the examiner. Specifically, Applicant amended claims 4, 5, 15, 16, 39, 41, 42, 43, 44, 45, 47, and 48, to address all 112-based rejections.

Continuing with the examiner's substantive rejections, the examiner rejects claims 1, 26-27, 34, and 42 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,304,549 to Srinivasan. All such anticipation rejections fail as a matter of law because Srinivasan does not disclose (explicitly or inherently) the claimed methods and apparatus of managing a radio channel. Srinivasan exclusively discloses dynamic management of Asynchronous Mode Transfer (ATM) channels—note that Srinivasan does state that it can manage ATM channels between radio base stations, but, by definition, those are backhaul ATM-based network links and not air interface radio channels within the meaning of Applicant's claims.

The law of anticipation is quite clear. A finding of anticipation is proper only if the cited reference discloses each and every limitation of the claimed invention, is enabling, and describes the claimed invention sufficiently to have placed it into the possession of one of ordinary skill in the art. In re Paulson, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994). More succinctly, the law of anticipation requires that the allegedly anticipating reference discloses each and every limitation of the claimed invention. Moba, B.V. v. Diamond Automation, Inc., 235 F.3d 1305, 66 USPQ2d 1429 (Fed. Cir. 2003). See, also, In re Bond, 910 F.2d 931, 15 USPQ2d 1566 (Fed. Cir. 1990) (stating that a prior art reference anticipates the claim in question only if every element of the claimed invention is identically shown in the reference, in the same arrangement as claimed).

Srinivasan does not disclose the claimed management of radio channels, and it is legally improper for the examiner to assert that it does, based on a statement in Srinivasan that its ATM management can be used for managing ATM (not radio) channels between radio base stations. For this reason alone, the examiner's anticipation rejections fail as a matter of law, and must be withdrawn.

The examiner further uses Srinivasan to reject claims 21-22 and 35 under 35 U.S.C. § 103(a), as being obvious over Srinivasan in further view of U.S. Patent No. 6,690,938 to Chin. This obviousness rejection fails as a matter of law because Srinivasan does not anticipate the independent claims from which these claims depend.

Further, the examiner's obviousness arguments are based on a misstatement of Chin. For example, the examiner cites to Chin at col. 5, lines 64-67, for the proposition that Chin teaches deallocating radio channels within the meaning of claims 21 and 35. The cited passage of Chin states that if the remaining number of traffic channels in the system of Chin falls below some minimum number, then Chin deallocates some number of supplemental traffic channels and reallocates them as (regular) traffic channels. (Note that Chin does this to assure fundamental traffic channel availability for new caller admissions.)

In any case, Chin does not teach or suggest monitoring a radio channel for usage and dropping that channel if the usage is below a minimum capacity defined by the system, and no one skilled in the art would thus find any motivation for combining Chin with Srinivasan in the manner suggested by the examiner.

As explained in Section 2142 of the MPEP, the examiner bears the initial burden of making out a prima facie case of obviousness under 35 U.S.C. § 103. Establishing

the prima facie case depends on meeting three basic criteria: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP, § 2142.

The prior art relied upon by the examiner in advancing an obviousness rejection must teach or suggest the claimed combination and a reasonable expectation of success with regard to making the claimed combination, and it is legally impermissible for the examiner to rely on the applicant's disclosure for such teachings. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). More specifically, the examiner bears the burden of presenting a convincing line of reasoning as to why the skilled artisan would have found the claimed invention obvious in light of the teachings of the references. Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985).

Ultimately, whether an invention is obvious over the prior art is a question of law, supported by an underlying factual analysis. In re Berg, 320 F.3d 1310, 65 USPQ2d 2003 (Fed. Cir. 2003). More significantly, with respect to the examiner's obviousness rejection, the determination of whether there is a motivation or suggestion to combine references is a factual question based on specific findings. Gartside, 203 F.3d 1305. On that point, the substantive question is whether one of ordinary skill in the art would have been motivated to combine the references in question. Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir. 2000).

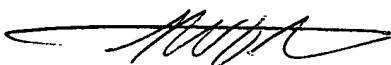
In the instant case, the primary reference (Srinivasan) does not teach management of radio channels, which is the principal basis for its use in making the obviousness rejection, and the secondary reference does not teach dropping radio channels—or any channels—as a function of determining that usage had dropped below some minimum. As such, the examiner's argument for combination of references fails to teach or suggest the claimed invention, and there is no motivation to combine them. All obviousness rejections therefore fail as a matter of law and should be withdrawn.

With the above remarks in mind, Applicant appreciates the examiner's indication of allowable subject matter, but believes that all claims stand in condition for immediate allowance over Srinivasan and/or Chin. As such, Applicant looks forward to the examiner's next correspondence.

Respectfully submitted,

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